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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,265	09/28/2000	Michael Bott	BMID9975US	8449

7590

10/09/2003

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EXAMINER
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PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/09/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/672,265

Applicant(s)

BOTT ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 19, 20 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 19, 20 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/7/03 has been entered.

Claims 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 13.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16, 17, 19, 20, and 24-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the genes *citC*, *citD*, *citE*, *citF* and *cit G* from *Klebsiella pneumoniae* in that order transformed into *E. coli* and the *citX* gene from *E. coli*, does not reasonably provide enablement for the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The examiner has reread the instant specification and has changed the instant rejection slightly and therefore made the rejection non-final.

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Applicants argue that "[w]hile the specific words 'at least four genes derived from *Klebsiella pneumoniae*' are not found within the specification, it is clear from a reading of the specification that embodiments within the claim scope are taught...[f]or example, on page 5, first full paragraph, the Applicants disclose simultaneous expression of the citCDEFG gene cluster from *Klebsiella pneumoniae* along with the citX gene from *E. coli*...[and that] this embodiment falls within the scope of the claim". The claims are now limited to a method for producing citrate lyase activity by using a plasmid that contains the "citC, citD, citE, citF, citG and a DNA fragment obtainable from *E. coli* that is located between the citF and citG on the *E. coli* citrate lyase gene cluster and an inducible promoter, and wherein at least four genes are derived from *Klebsiella pneumoniae*". Nowhere in the specification is it taught that "at least four genes from *klebsiella pneumoniae*" are included in the operable invention. These four genes could be entirely unrelated to citC, citD, citE, citF and citG or some of them could be. They could be in a different order and applicants have not shown this would be operable. Apparently, the only recitation concerning what is in the instant claims is the instant recitation on page 5.

On page 2, first full paragraph, it is taught that when the *Klebsiella pneumoniae* genes coding for citrate lyase were placed in *E. coli*, the protein produced was inactive. These *Klebsiella pneumoniae* genes are presumably the citC, citD, citE, citF and citG genes in that order. Therefore, the addition of citX from *E. coli* somehow makes the citrate lyase active. This active embodiment is apparently what is attempted to be claimed here. The examiner cannot find any other recitation in the specification concerning the order or identity of the genes. The order of "citCDEFXG" mentioned in the previous rejection was apparently from the paragraph spanning pages 4-5 and the first


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sentence of the first full paragraph on page 15, but that recitation is talking about the *E. coli* gene cluster, which is not what is claimed the instant claims. Apparently Examples 1-5 do not disclose anything about what embodiment produces an active citrate lyase.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Charles L. Patterson, Jr.  
Primary Examiner  
Art Unit 1652

Patterson  
October 8, 2003